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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,000	01/16/2004	Jean Qiu		8672

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EXAMINER	
AMARI, ALESSANDRO V	

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/760,000	QIU, JEAN	
	Examiner	Art Unit	
	Alessandro V. Amari	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) *2,3,6 and 15-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5 and 7-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4, 5, 7-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blatt et al US 4,761,381 in view of Mitchell US 4,997,266.

In regard to claim 1, Blatt et al teaches (see for example, Figs. 1-3) a unitary chamber for counting microscopic objects in a liquid sample comprising a top part (2), a base part (4) disposed substantially parallel to the top part, a connecting layer (3) disposed between said top part and said base part, the connecting layer having an opening to receive the liquid sample, a sample introduction port (7) for introducing the liquid sample into a volume defined by said top part, said base part and the opening in said connecting layer and an air escape port (5) for permitting air to escape from the volume as shown in Figure 1 and as described in column 5, lines 15-45.

However, in regard to claim 1, Blatt et al does not teach a counting grid.

In regard to claim 1, Mitchell teaches (see Fig. 2, 3) a counting grid (19). Regarding claims 4 and 5, Mitchell teaches that the counting grid is an integral part of the base part and that the counting grid is on the top side of said bottom part as described in column 3, lines 48-65. Regarding claims 7, 8 and 9, Mitchell teaches that said counting grid lines width range from 0.1 micrometer to 1mm as described in column

5, lines 1-2 and 27-29. Regarding claims 10-12 and 14, Mitchell teaches the manufacture of the counting grid onto the top side of the base part as described in column 3, lines 60-68 and column 4, lines 1-56. Applicant should note that while the prior art does not teach manufacture of the counting grid by way of radiation polymerizable solution as claimed, the claims are considered product-by-process claims and in product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the counting grid of Mitchell in the chamber of Blatt et al in order to more accurately determine the concentration or counting and inspection of suspended particulate matter, liquid samples or other specimens.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blatt et al US 4,761,381 in view of Mitchell US 4,997,266 and further in view of Fisch US Re 35,589.

Regarding claim 13, Blatt et al in view of Mitchell teaches the invention as set forth above but does not teach that the counting grid is manufactured on the bottom side of the top part. Applicant should note that while the prior art does not teach manufacture of the counting grid by way of a polymerizable solution as claimed, the claims are considered product-by-process claims and in product-by-process claims,

"once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 13, Fisch does teach (see Figs. 2a, 2b, 3a) that the counting grid (38) is on the bottom side (32) of the top part (3) as described in column 4, lines 4-11.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to put the counting grid on the bottom side of the top part as taught by Fisch for the chamber of Blatt et al in view of Mitchell so that the counting gird is more visible to the observer to provide more precision for determining the concentration or inspection of suspended particulate matter, liquid samples or other specimens.

Response to Arguments

4. Applicant's arguments filed 6 October 2005 have been fully considered but they are not persuasive.

The applicant argues that Blatt is concerned with determining whether certain components are present in a liquid sample and not with counting particles. Therefore, the applicant maintains that it would not be obvious to combine Blatt with the counting grid pattern of Mitchell since this would render Blatt's device unsuitable for its intended purpose.

In response to this argument, the Examiner would first like to point out that both Blatt and Mitchell are in the same field of endeavor. Furthermore, Blatt teaches that its device enables visual or other sensing means to ascertain the presence of a sought after components in the liquid sample and/or the amount of said component (see column 1, lines 15-20 of Blatt). Therefore, it would have been obvious to combine Blatt with the counting grid of Mitchell to enable the quantification of the amount of a particular component. Blatt further teaches the analysis of biological fluids such as blood and urine (see column 1, lines 24-26) and it would certainly be obvious to incorporate a counting grid as taught by Mitchell into Blatt's device so as to provide a scale or reference so as to ascertain the inspection of a sample such as blood more easily and accurately. Furthermore, the applicant fails to provide a reason or rationale backing up the applicant's assertion that adding the grid pattern would render Blatt's device unsuitable for its intended purpose. There is every reason to believe that adding a counting grid to the device of Blatt would enhance its capability for analysis of liquid samples.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Elkins US 4,441,793 teaches a unitary chamber for analysis of microscopic objects in a liquid sample.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

avaulq
12 December 2005

MARK A. ROBINSON
PRIMARY EXAMINER